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In the Supreme Court of the United States

OCTOBER TERM, 1935

No. —

UNITED STATES OF AMERICA, PETITIONER

v.

ROBERT ESNAULT-PELTERIE

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF CLAIMS OF THE UNITED STATES

The Solicitor General, on behalf of the United States of America, prays that a writ of certiorari issue to review the interlocutory judgment of the Court of Claims of the United States entered in the above cause on January 24, 1936.

OPINION BELOW

The opinion of the Court of Claims is not yet reported.

JURISDICTION

The interlocutory judgment of the Court of Claims was entered January 24, 1936. The jurisdiction of this Court is invoked under Section 3 (b) of the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the patent in suit may be construed to cover a single lever for controlling the equilibrium of an airplane, or whether it should be construed as being limited to a combination comprising a lever and a single integral or unitary tail structure of an airplane.

2. If the patent in suit may be construed to cover a single lever for controlling the equilibrium of an airplane, whether such a device was patentable over prior disclosures.

3. Whether the patent in suit covers a device that was patentable over respondent's French patent, No. 372753, which was applied for more than a year prior to the filing in this country of the application for the patent in suit.

4. Whether the patent in suit, application for which was filed in this country on January 16, 1908, is invalid by virtue of the fact that the claims alleged to cover the single control lever here involved were not inserted in the application until June 12, 1913; the control lever, during the intervening period, having come into general use in the United States, and having been described in printed publications.

5. Whether the respondent, by acquiescing in the rejection by the examiner of patents of claim 13, is estopped from contending that the claims of the patent in suit should be construed to cover a single lever for operating the means for controlling the equilibrium of an airplane.

6. Whether the patent in suit is invalid by virtue of the fact that its claims, if construed to embrace a single equilibrium control lever, are not supported by its disclosure.

7. Whether the patent in suit is invalid by virtue of the fact that the control lever alleged to be covered by it was in public use in France prior to the date of its alleged invention by the respondent.

8. Whether the claims of the patent in suit were infringed by the United States.

STATUTES INVOLVED

The statutes involved will be found in the Appendix, *infra,* pp. 18–21.

STATEMENT

This suit was brought by the respondent, Robert Esnault-Pelterie, a citizen of France, against the United States in the Court of Claims to recover compensation for the use of an airplane control device said to be covered by United States Patent No. 1115795 issued to respondent on November 3, 1914. This device consists of a universally pivoted vertical lever, known as a joy-stick, utilized for controlling the longitudinal and transverse equilibria of airplanes and so connected that the tilt of the airplane follows the tilt of the stick. The device is generally employed in all but the heavier types of airplanes in use by both the Army and the Navy. Finding XLVII.

The court below found that at least one of each of three types of airplanes, Curtiss *JN-4D,* DeHavi-

land *DH–4B,* and Loening monoplane *M–81* was manufactured for and used by the United States without license or permission from the respondent (Finding XIX), and it was stipulated between the parties that proof of the manufacture for or use by the United States of any airplanes other than these three might be deferred until after an adjudication of the questions of validity and infringement of the patent in suit. Finding XXIII. The control systems of the Curtiss, DeHaviland, and Loening planes referred to are substantially the same.

These planes are steered directionally by a rudder which is controlled by a centrally pivoted horizontal rudder bar or lever situated directly in front of the pilot and in position for actuation by the pilot's feet. The longitudinal attitude of the planes is controlled by a tail surface, pivoted on a horizontal axis and generally known as the "elevator", which by being turned up or down causes the airplane to ascend or descend, as required. The lateral attitude is controlled by hinged segments of the wings, generally known as ailerons. The latter are turned up or down, as the case may be, in order to cause the airplane to tilt or "bank" to one side or the other as desired. The vertical lever known as the joy-stick, claimed to infringe the patent in suit, is located near the pilot's seat and is manually operated. It is capable of movement in all directions, and is so connected with the ele-

vator and the ailerons that by a fore-and-aft motion it actuates the elevator, by a side-to-side motion it actuates the ailerons, and by an oblique movement it affects both the ailerons and the elevator simultaneously. When the joy-stick is moved forward the airplane noses down; when it is moved rearwardly the airplane noses up; when the lever is moved to the right, the plane rolls to the right; when it is moved to the left the plane rolls to the left; and when the lever is moved to any intermediate position a consequent movement of the airplane will be produced corresponding relatively to the degree of inclination and the direction of movement of the lever. Findings XXI and XXII.

The respondent in this suit relies upon claims 2 and 5 to 9, inclusive, of his Patent No. 1115795. These claims are set out in Finding IX.

The court below on November 4, 1935, filed special findings of fact, and on January 24, 1936, it directed the entry of an interlocutory judgment, holding that the respondent's patent is valid and has been infringed by the United States, and that the respondent is entitled to compensation under the Act of June 25, 1910, as amended by the Act of July 1, 1918. An interlocutory judgment was entered accordingly.

SPECIFICATION OF ERRORS TO BE URGED

The Court of Claims erred:

1. In holding that the patent in suit covers a single control lever that was patentable over prior disclosures.

2. In failing to hold that the claims of the patent in suit should be construed as being limited to a combination comprising a lever and a single integral or unitary tail structure of an airplane.

3. In holding that the patent in suit covers a device that was patentable over respondent's French patent, No. 372753, applied for on December 19, 1906, and issued on February 28, 1907.

4. In failing to hold that the patent in suit was invalid by virtue of the fact that although the application therefor was filed on January 16, 1908, the claims alleged to cover the single control lever here involved were not inserted into the application until June 12, 1913; the control lever, during the intervening period, having come into general use in the United States, and having been described in printed publications.

5. In failing to hold that respondent was estopped, by acquiescing in the rejection by the examiner of patents of claim 13, from contending that the claims of the patent in suit should be construed to cover a single lever for operating the means of controlling the equilibrium of an airplane.

6. In failing to hold that the patent in suit, if construed to embrace a single control lever, is invalid by virtue of the fact that its claims are not supported by its disclosure.

7. In failing to hold that the patent in suit, if construed to embrace a single control lever, is invalid by virtue of the fact that the control lever

alleged to be covered by the patent was in public use in France prior to the date of its alleged invention by the respondent.

8. In holding that the claims of the patent in suit were infringed by the United States.

REASONS FOR GRANTING THE WRIT

1. The Court of Claims in this case and the Circuit Court of Appeals for the Second Circuit in *Esnault-Pelterie* v. *Chance Vought Corporation,* 66 F. (2d) 474, have rendered conflicting decisions on the validity and construction of the patent in suit and its infringement by modern airplane control levers. In the *Chance-Vought* case the Circuit Court of Appeals, in affirming the decision of the District Court for the Eastern District of New York (56 F. (2d) 393) held (pp. 477, 478) that, in view of the prior art, there was no novelty in the use of a single vertical lever capable of movement in any direction to operate two or three controls, or in determining, as an engineering problem, the choice as to which of the three controls should be operated by the single lever; that the patentee of the patent in suit may not claim invention in the asserted instinctive use by the operator of the control lever; that the patent should be narrowly construed as limited to the integral vertical and horizontal rudder structure disclosed in respondent's patent employing the so-called bird tail or ringtail unit for control, with a restricted

range of equivalents; and that, as so construed, the patent was not infringed by the airplane of the defendant in that suit. In the case at bar, the court below held that the patent should not be limited to the integral vertical and horizontal rudder structure of the bird tail or ringtail unit, but should be broadly construed as covering a single vertical control stick whereby the entire equilibrium of an airplane may be controlled with a single instinctive tilt of the control stick in any direction, causing the plane to tilt in a similar direction; and that as so construed the patent was valid and was infringed by the airplanes of the United States using such a control stick. The airplane involved in the *Chance-Vought* case and those involved in the present case employed the single control lever. The construction and function of the lever were the same in each instance.

2. The questions of the validity and construction of the patent in suit and its infringement by modern airplane controls are of momentous importance both to the Government and to the entire aircraft industry, due to the extensive use of the control lever. In view of the conflict of opinion between the Court of Claims and the Circuit Court of Appeals for the Second Circuit, as to whether the patent in suit covers such a control lever, a final adjudication should be had by this Court. The amount involved in this suit alone is very large, as it is assumed that on the accounting the

respondent would claim a royalty on the great majority of airplanes used by the Government during the period commencing six years prior to the institution of the action and the expiration of the patent. This suit has been pending for a number of years.

3. The petition for a writ of certiorari is presented at this stage of the case—after an entry of an interlocutory judgment holding the patent valid and infringed—rather than after final judgment, since, if this Court should grant the writ and reverse the decision of the court below, prolonged and costly accounting proceedings may be avoided.

4. It is submitted that the decision of the Court of Claims is erroneous, for a number of reasons.

(a) The single lever for controlling the longitudinal and transverse equilibrium of an airplane alleged to be covered by the patent in suit does not constitute a patentable invention. The use of a single lever mounted on a universal joint and capable of movement in all directions for the purpose of controlling the action of different mechanisms, was well known at the time that the patentee claims to have made his invention. (See patents to Wadsworth, Weeber, Wilson, and Simpson, described in Findings XXIV, XXXII, XXXIII, XXXVI, and XXXVII.) This Court has frequently held that it does not constitute invention to take a well-known device and put it on a new type of apparatus. *Blake* v. *San Francisco,*

113 U. S. 679, 682; *Pennsylvania Railroad Co.* v. *Locomotive Co.*, 110 U. S. 490; *Wollensak* v. *Sargent*, 151 U. S. 221, 227. The use of levers in airplanes for control purposes was likewise old. (See French patent to Laroze; French patent to Penaud and Gauchot; British patent to Davidson; French patent to Macedo; German patent to Schussler; German patent to Jung and British patent to Quentin, all of which are summarized in Findings XXIV, XXVIII, XXV, XXVI, XXVII, XXIX, XXX, and XXXV.) On this point the Circuit Court of Appeals stated in *Esnault-Pelterie* v. *Chance Vought Corporation*, 66 F. (2d) 474, 478:

> There is no novelty in the use of a lever to operate two or three controls, or in determining, as an engineering problem, the choice as to which of the three controls should be operated by a single lever.

The Court of Claims, moreover, indicated that the fact that, in its opinion, the control lever operated in a manner that it called instinctive, was a reason for holding that the device was the product of inventive genius, and, therefore, the proper subject of a patent. This suggestion was discussed in detail by the Circuit Court of Appeals and repudiated, 66 F. (2d) 477.

(b) The plaintiff obtained three French patents. His first French patent was issued on February 28, 1907, as the result of an application filed on December 19, 1906 (Finding III). The application

for the patent in suit was filed in the United States on January 16, 1908, more than twelve months subsequent to the French filing date. Consequently, under Section 4887 of the Revised Statutes (U. S. Code, Title 35, Sec. 32), *infra* p. 18 the plaintiff was barred from receiving a patent in this country on the invention covered by his first French patent. The patent in suit may, therefore, be sustained only if, and in so far as, it claims a structure that is patentable over the 1906 French patent. The latter disclosed two horizontal levers, one of which was movable in all directions, employed for the purpose of manipulating the control surfaces of an airplane. Finding IV. The patent in suit shows two vertical levers used for that purpose. The principal difference in the two structures is the difference in position between the two levers—one horizontal, the other vertical. We submit that it was not invention to transpose the horizontal stick to a vertical position. *Wollensak* v. *Sargent, supra; Underwood* v. *Gerber,* 149 U. S. 224; *Olmstead* v. *Andrews & Co.,* 77 Fed. 835; *Toledo Scale Co.* v. *Computing Scale Co.,* 9 F. (2d) 823, 824; *Barnes Automatic Sprinkler Co.* v. *Walworth Manufacturing Co.,* 60 Fed. 605, 607. Both the District Court and the Circuit Court of Appeals in the *Chance-Vought* case so held on this point, 56 F. (2d) 395; 66 F. (2d) 475, 477, 478.

(c) The claims, even if valid, should be limited to a combination comprising a single integral or

unitary tail structure. The specification forming a part of the respondent's patent discloses a structure in which the tail surfaces, instead of comprising a separate elevator and a separate rudder, as is the case with all modern airplanes, consists of a single integral or unitary structure to be used both as an elevator and as a rudder, according to the direction in which it is manipulated by the control levers. The Circuit Court of Appeals in the *Chance-Vought* suit held that, in the light of the prior art, the claims of the respondent's patent in no event could be permitted to read broadly on the modern vertical control lever, but at best should be limited and restricted to a combination of the control levers with an integral or unitary tail structure, 66 F. (2d) 478. This Court has not infrequently placed a narrow construction on and limited patent claims so as to conform them to the exact disclosure, in order to save them from being declared entirely invalid. *Sargent* v. *Hall Safe & Lock Co.*, 114 U. S. 63; *Snow* v. *Lake Shore and Michigan Southern Railway Co.*, 121 U. S. 617, 629; *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245, 256. On this point there is a direct conflict between the Court of Claims in this case, and the Circuit Court of Appeals in the *Chance-Vought* case.

(d) The respondent filed his application for Letters Patent in this country on January 16, 1908. The patent was issued on November 3, 1914. The

claims alleged to have been infringed were inserted into the application by amendment on June 12, 1913 (Finding VIII). During a part of the period intervening between January 16, 1908, and June 12, 1913, the application contained no claims covering the control lever. Yet during that period the device came into general use in this country (Finding XXXVIII, paragraphs 1 and 2). We submit that these facts rendered the patent invalid. *Railway Co.* v. *Sayles,* 97 U. S. 554, 563–564; *James* v. *Campbell,* 104 U. S. 356, 370; *Webster Electric Co.* v. *Splitdorf Electrical Co.,* 264 U. S. 463, 465; *Cramer Manufacturing Co.* v. *Nims Pump Co.,* 9 F. (2d) 914; *Dwight & Lloyd Sintering Co.* v. *Greenawalt,* 27 F. (2d) 823, 830.

(e) The court below should have held that respondent was estopped from claiming that his patent covers a single control lever because of respondent's acquiescence in the rejection by the Patent Office of respondent's claim 13. Claim 13 was filed February 1, 1909, and was for "An aeroplane having means for controlling its inclination and a single lever for operating said means to control both the longitudinal and the transverse stability of the apparatus, said lever being arranged to oscillate in different vertical planes, means for transmitting its movement in one plane to the means for governing the longitudinal inclination, and means for transmitting its movement in the other plane to the means for determining

the transverse stability, said lever being mounted to permit also an oblique movement having components in each of said planes so as to actuate simultaneously the means for establishing longitudinal stability and that for establishing transverse stability." The examiner of patents on March 2, 1909, rejected the claim for alleged lack of invention over the French patent to Laroze. The respondent asked for a reconsideration of the claim, and the examiner on May 10, 1910, and again on May 27, 1911, rejected the claim, this time on the basis of the Davidson as well as the Laroze patent. On May 23, 1912, the respondent cancelled the claim. On June 12, 1913, respondent filed a new set of four claims, and on June 13, 1914, filed an additional claim. These claims were subsequently allowed as claims 5 to 9, inclusive, of the patent in suit. Finding VIII. They appear in Finding IX, and each is for a combination of means for producing lateral stability, means for producing longitudinal stability, and a single vertical lever.

The principle is well settled that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. If the claim to a combination

be restricted to specified elements, all must be regarded as material, and limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Smith* v. *Magic City Club,* 282 U. S. 784, 789.

(f) The patent should have been held invalid also on the ground that the claims, if construed as respondent contends they should be, are not supported by the disclosure. In other words, the specification describes one type of structure, whereas the claims alledgedly cover a device which is entirely different. It is well settled that under such circumstances the claims are invalid. *Knox* v. *Quicksilver Mining Co.,* 4 Fed. 809; *Fulton Co.* v. *Powers Regulator Co.,* 263 Fed. 578, 580; *Westinghouse Electric & Manufacturing Co.* v. *Metropolitan Electric Mfg. Co.,* 290 Fed. 661, 664. In this instance, the device disclosed in the patent consists of two levers, one to control the steering and the other for manipulating the means for maintaining longitudinal and lateral stability. The two levers are interconnected and interrelated (Finding XIV). The claims in suit purport to cover a single vertical lever to actuate the longitudinal and lateral controls. The Government's

position on this point accords with the decision of the Circuit of Appeals in the *Chance Vought* case, 66 F. (2d) 477.

(g) Prior to the date of the respondent's alleged invention, single levers mounted on universal joints and capable of movement in all directions had actually been used on airplanes for the purpose of actuating the control surfaces. This was done by Captain Ferber in 1904 and 1905 (Finding XLI), and by Bleriot, who later became famous as the first aviator to fly across the English Channel (Finding XLIII). This prior use, however, took place in France, and the court below held that in order to bar a United States patent prior public use must have taken place in this country, in view of the provisions of Revised Statutes, Section 4923, *infra,* p. 19. Undoubtedly that is the law in case of an American patentee, but the question whether R. S. 4923 should be applicable to a situation such as is presented here, where the patentee is a citizen of the foreign country where the prior use took place, has never been directly passed upon by this Court, or by any other court. It is increasingly important with the growth of modern means of communication and interchange of information.

(h) In the *Chance-Vought* case, the Circuit Court of Appeals held that the claims of respondent's patent had not been infringed by the *Chance-Vought* Corporation. The court below, differing

with the Circuit Court of Appeals as to the scope of the patent, held that the claims of the patent had been infringed by the Government. If the claims be restricted as they were by the Circuit Court of Appeals, and as we contend they should be, there can be no doubt that the Government airplanes do not infringe them.

Wherefore, it is respectfully submitted that this petition for a writ of certiorari should be granted.

STANLEY REED,
Solicitor General.

APRIL 1936.

APPENDIX

R. S., Section 4886 (U. S. C., Title 35, Sec. 31):

> Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

R. S., Section 4887 (U. S. C., Title 35, Sec. 32):

> No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and four months in cases of designs, prior to the

filing of the application in this country, in which case no patent shall be granted in this country.

An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing.

R. S., Section 4923 (U. S. C., Title 35, Sec. 72):

Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known

or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.

Act of June 25, 1910, as amended by Act of July 1, 1918 (U. S. C., Title 35, Sec. 68):

> Whenever an invention described in and covered by a patent of the United States shall be used or manufactured by or for the United States without license of the owner thereof or lawful right to use or manufacture the same, such owner's remedy shall be by suit against the United States in the Court of Claims for the recovery of his reasonable and entire compensation for such use and manufacture. The Court of Claims shall not entertain a suit or award compensation under the provisions of this section where the claim for compensation is based on the use or manufacture by or for the United States of any article owned, leased, used by, or in the possession of the United States prior to June 25, 1910. In any such suit the United States may avail itself of any and all defenses, general or special, that might be pleaded by a defendant in an action for infringement, as set forth in this chapter, or otherwise. The benefits of the provisions of this section shall not inure to any patentee who, when he makes such claim, is in the employment or service of the Government of the United States, or the assignee of any such patentee. This section shall not apply to any device discovered or invented by such employee during the time of his employment or service.

Judicial Code, Section 155 (U. S. C., Title 28, Sec. 261):

> Aliens who are citizens or subjects of any Government which accords to citizens of the United States the right to prosecute claims against such Government in its courts, shall have the privilege of prosecuting claims against the United States in the Court of Claims, whereof such court, by reason of their subject matter and character, might take jurisdiction.

U. S. GOVERNMENT PRINTING OFFICE: 1936